

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/659,930	09/11/2003	Wayne E. Cornish	ACS 65357 (1512XCC)	5064
7590 11/08/2006			EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP			, ROY, ANURADHA	
Howard Hughes Center Tenth Floor		ART UNIT	PAPER NUMBER	
6060 Center Drive			3736	
Los Angeles, C	CA 90045		DATE MAILED: 11/08/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

			(
	Application No.	Applicant(s)				
	10/659,930	CORNISH ET AL.				
Office Action Summary	Examiner	Art Unit	-			
	Anuradha Roy	3736				
The MAILING DATE of this communication app	pears on the cover sheet with the c	orrespondence address				
Period for Reply	VIO OET TO EVOIDE A MONTH	(O) EDOM				
A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be tin y within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from t, cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 28 A	<u>ugust 2006</u> .					
2a)⊠ This action is FINAL . 2b)☐ This	☐ This action is FINAL . 2b)☐ This action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4:	53 O.G. 213.				
Disposition of Claims						
4) Claim(s) 64-84 is/are pending in the applicatio 4a) Of the above claim(s) is/are withdray 5) Claim(s) 71-84 is/are allowed. 6) Claim(s) 64-70 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/o	wn from consideration.					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex	epted or b) objected to by the drawing(s) be held in abeyance. Settion is required if the drawing(s) is ob	e 37 CFR 1.85(a). ijected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
12) ☐ Acknowledgment is made of a claim for foreign a) ☐ All b) ☐ Some * c) ☐ None of: 1. ☐ Certified copies of the priority document 2. ☐ Certified copies of the priority document 3. ☐ Copies of the certified copies of the priority application from the International Burea * See the attached detailed Office action for a list	es have been received. Is have been received in Applicat In rity documents have been receive In (PCT Rule 17.2(a)).	ion No ed in this National Stage				
Attachment(s)						
 Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 	4) Interview Summary Paper No(s)/Mail D 5) Notice of Informal F 6) Other:					

U.S. Patent and Trademark Office PTOL-326 (Rev. 1-04)

DETAILED ACTION

This action is in response to applicant's amendment submitted on August 28, 2006.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Please see office action of May 6, 2006.

Claims 64-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Sahatjian et al. (US Patent No. 5,283,004). Please see office action of May 6, 2006 for details.

Allowable Subject Matter

Claims 71-84 are allowed under the terminal disclaimer filed by the Applicant on December 15, 2005 and approved by the office on December 29, 2005.

Response to Arguments

Applicant's arguments filed August 28, 2006 have been fully considered but they are not persuasive. Applicant argues, "...linear behavior depicted on a stress-strain graph is not the same as a substantial linear change in stiffness..." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., bending stiffness) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Sanhatjian et

Art Unit: 3736

al. does anticipate an intracorporeal device comprising an elongated member (12) having means capable of causing a *substantially* linear change in stiffness over a longitudinal length of the elongated member (Column 4, lines 11 – Column 5, line 8, Column 5, lines 36-40 & Figures 4 & 4A), as claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3736

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is 571-272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 9:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR